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NAME: Examiner Stephen M. Brinich Group Art Unit: 2624
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Total Pages
(Including Cover Sheet): 9

Special instructions or supplemental message: Attorney Docket No. 98542-US-DIV1 -
NOTICE OF APPEAL, PETITION FOR EXTENTION OF TIME, and PRE-APPEAL
BRIEF REQUEST FOR REVIEW to follow.

Inventor(s): Robert P. Loe et al.
Application No.: 10/694,494
Filed: 10/27/2003
Examiner: Stephen M. Brinich
Art Unit: 2624
Confirmation No.: 4288
Title: **METHOD OF SELECTIVE EDGE SOFTENING AND RENDERING FOR THE
SUPPRESSION OF HALO**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW	
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Docket Number (Optional) 98542-US-DIV I	
Application Number 10/694,494	Filed 10/27/2003
First Named Inventor Robert P. Loce	
Art Unit: 2624	Examiner Stephen M. Brinich
Customer Number: 25453	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attach sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input checked="" type="checkbox"/> Attorney or Agent of record. Registration number 43,230</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34. _____</p> <p><u>Christopher D. Wait</u> Signature Christopher D. Wait Typed or Printed name 585-423-6918 Telephone Number 11-10-2005 Date</p>	

☐ Total of _____ forms are submitted.

MAIL TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

11/2005

PATENT APPLICATION
Attorney Docket No. 98542-US-DIV1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert P. Loce et al.

Application No.: 10/694,494

Filed: 10/27/2003

Examiner: Stephen M. Brinich

Art Unit: 2624

Confirmation No.: 4288

Title: **METHOD OF SELECTIVE EDGE SOFTENING
AND RENDERING FOR THE SUPPRESSION OF
HALO**

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Francis S. LePore

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

11/14/2005 HDESTA1 00000014 240025 10694494

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Application No. 10/694,494

REMARKS

Arguments to be Considered by Pre-Appeal Brief Conference Panel

Claims 1-3, and 9-14, are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,218,350, to Bollman (hereinafter Bollman). Claims 4-8, and 15, are objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form including all limitations of base and intervening claims. Claims 16 – 24 are allowed. The rejection under 35 U.S.C. §102(b) over Bollman is respectfully traversed.

Bollman does not teach *selective dilation*, Bollman teaches "conditional dilation". Bollman is not unknown to the Applicants, please see page 3, lines 18-33, of the Applicants' specification where Bollman is expressly disclosed. As is well understood by those skilled in the art, the approach taught by Bollman, is one of "conditional dilation". In contrast the teaching as taught and as claimed by the Applicants in the specification of the present Application is the utilization of "*selective dilation*". Considerable discussion and explanation of the differences between "conditional dilation" and the Applicants' "*selective dilation*" is taught in the present Application at page 7 lines 19-32, of the specification. Note in particular that *selective dilation* includes "the dilation of those shape edges which are only perpendicular to the fast scan direction, or in the alternative only perpendicular to the slow scan direction of an image marking process", please see page 7, lines 30-33. Bollman does not teach "*selective dilation*".

The Applicants have "with reasonable clarity, deliberateness, and precision" provided within the Application Specification the definition of *selective dilation*. The Applicants have further pointed out this controlling language to the Examiner as will be found in the Applicants' Amendment and

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Response papers dated 1/10/2005, page 9. Therein on page 9 of the Applicants' Amendment, the Applicants not only provide both citation to the Specification at page 7, lines 15-28 of the Application, but they also "cut & pasted" for the benefit of the Examiner this cited controlling language from the Application Specification directly into the Amendment and Response papers dated 1/10/2005, again at page 9.

The Examiner has clearly chosen to ignore the Applicants' definition of *selective dilation*. In the Examiner's Response to Arguments, date mailed 06/10/2005, Examiner states:

"Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."

which is clear indication that the Examiner is ignoring Applicants' definition that *selective dilation* equates to conditional dilation (shape edges which do not touch another shape will not be dilated), and is intended to further include the dilation of those shape edges which are only perpendicular to the fast scan direction, (or in the alternative only perpendicular to the slow scan direction of an imaging marking process). MPEP 2111.01 requires that where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim, please note:

MPEP 2111.01 Plain Meaning

III. <APPLICANT MAY BE OWN LEXICOGRAPHER

****>**An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*,

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30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). ***Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.*** *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)

Further, as MPEP 2111.01 requires that an Applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term, a requirement for a prima facie rejection under 35 U.S.C. §102(b) has not been met.

Thus, it is deemed appropriate to request a panel of experienced Examiners to formally review the rejections in this Application as 1) the presence of a clearly improper rejection by way of ignoring MPEP 2111.01 has been established, and 2) an omission of essential elements as required to establish a prima facie rejection, has been identified.

For at least the above-stated reasons, Applicants respectfully request a pre-appeal review for the reasons set forth above.

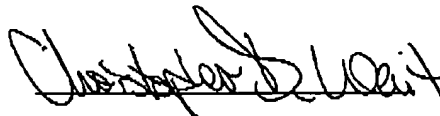
No additional fee is believed to be required for this Pre-Appeal Brief Request for Review; however, the undersigned Xerox Corporation attorney

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authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event any Examiner considers personal contact advantageous to the disposition of this case, that Examiner is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



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November 10, 2005
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